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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,186

12/01/2003

Gregory J. Boss

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EXAMINER

DURAN, ARTHUR D

ART UNIT

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3622

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,186	<b>Applicant(s)</b> BOSS ET AL.	
	<b>Examiner</b> Arthur Duran	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/1/03</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Claims 1-40 have been examined.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. To correct this issue, the independent claim could be amended such that at least one significant feature (not just data gathering or outputting) of the body of the claims actively uses a technological apparatus (computer, server, processor, etc).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-8, 16-28, 31-37, 40 are rejected under 35 U.S.C. 102(a) as being anticipated by Cowden (2003/0098882).

Claim 1, 21, 31: Cowden discloses a method of managing a display of an unsolicited instant advertisement, comprising:

detecting an attempt to display the unsolicited instant advertisement in a primary browser window; and

relocating the unsolicited instant advertisement to an alternate location that is not part of the primary browser window, without deleting the unsolicited instant advertisement ([81]; Figures 7, 8).

Claims 2, 22, 32: Cowden discloses the method of claim 1, wherein the alternate location comprises a secondary browser window ([81, 11]).

Claims 3, 23, 33: Cowden discloses the method of claim 1, wherein the alternate location comprises a container ([81]).

Claims 4, 24, 34: Cowden discloses the method of claim 1, wherein the alternate location comprises any one of a file or a database ([81]).

Claims 5, 25, 35: Cowden discloses the method of claim 1, further comprising automatically displaying the unsolicited instant advertisement in the primary browser window if the unsolicited instant advertisement meets a user-defined authorization criterion (Figure 7).

Claims 6, 26: Cowden discloses the method of claim 1, further comprising filtering the unsolicited instant advertisement by a user-defined filtering criterion (Figure 7).

Claims 7, 27, 36: Cowden discloses the method of claim 6, further comprising filtering the unsolicited instant advertisement by a plurality of user-defined filtering criteria; and further automatically displaying the unsolicited instant advertisement in the primary browser window if the unsolicited instant advertisement meets at least some of the plurality of user-defined filtering criteria (Figure 7).

Claims 8, 28, 37: Cowden discloses the method of claim 6, further comprising deleting the unsolicited instant advertisement that fails the filtering criterion (Figure 7; [81]).

Claims 16: Cowden discloses the method of claim 1, further comprising recording an attempt to display an unsolicited instant advertisement is recorded in a log (Cowden, [63]; also, [8] in the Applicant's Specification as to "Background of the Invention").

Claim 17: Cowden discloses the method of claim 16, further comprising transmitting the log to the user ([112]).

Claim 18: Cowden discloses the method of claim 1, further comprising saving the unsolicited instant advertisement in an original form with corresponding text, graphics, and hypertext links ([81]).

Claims 19: Cowden discloses the method of claim 1, further comprising saving the unsolicited instant advertisement in a digest form without graphics ([81]).

Claims 20, 40: Cowden discloses the method of claim 1, wherein the unsolicited instant advertisement comprises any of a pop-up advertisement or a pop-under advertisement ([6]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 9-15, 29, 30, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowden (2003/0098882) in view of Loughmiller (2005/0076084).

Claims 9, 29, 38: Cowden discloses the above. Cowden discloses a filtering criterion (Figure 7) and saving bad pop-ups for later viewing ([81] and rejection above). Cowden further discloses presenting ads of interest to the user (Figure 7; [10, 11]). Cowden does not explicitly disclose saving the unsolicited advertisement that meets the filtering criterion. However, Loughmiller discloses filtering, classifying, organizing, and storing both good and bad messages/pop-ups (Abstract, Figure 5) and that Loughmiller's system can work with a variety of content/messages including pop-ups ([14, 126, 129]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Loughmiller's filtering content and storing both good and bad content can be added to Cowden's filtering content and storing bad content. One would have been motivated to do this in order to allow Cowden's users to view ads of interest at their discretion.

Claims 10, 30, 39: The prior art discloses the method of claim 9, Cowden further discloses notifying a user that the unsolicited instant advertisement has been saved (Figure 8; [81]).

Claims 11: The prior art discloses the method of claim 10, Cowden further discloses notifying the user comprises presenting a visual indicator in the primary web browser (Figure 8).

Claim 12: The prior art discloses the above. Cowden does not explicitly disclose notifying the user comprises presenting an audible indicator. However, Cowden discloses notifying the user via an alert (Figure 8) and Cowden discloses that the computer has audio capabilities ([36]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Cowden can alert the user with audible sounds. One would have been motivated to do this in order to alert the user in a commonly known way of alerting users that is a desirable form for alerting to many users.

Claim 13: The prior art discloses the above. And, Cowden further discloses categorizing windows ([10]) and Loughmiller discloses prioritizing and categorizing windows that have been saved (citations above). Also, please see the rejection of claim 9 above.

Claims 14: The prior art discloses the method of claim 13, Cowden further discloses aggregating unsolicited instant advertisements in the alternate location ([81]).

Claim 15: The prior art discloses the method of claim 14, Cowden further discloses that the unsolicited instant advertisements are stored with corresponding descriptions ([107, 108]).

***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Lapidous and Pennell disclose relevant features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran  
Primary Examiner  
Art Unit 3622

/Arthur Duran/



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6/15/09